

RESPONSE

Claims 2, 4-11, 14, 34-35 and 36-40 are pending the applications. Claims 36 and 37 are in independent format.

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to only selected ones of the Examiner's assertions, but intends to traverse all of the Examiner's assertions.

TELEPHONE INTERVIEW WITH THE EXAMINER ON JUNE 2, 2009

The Applicant very sincerely thanks the Examiner for his courtesy and insight during the telephone interview on June 2, 2009. The Applicant sincerely thanks the Examiner for his effort on negotiating suggested claim language.

The Examiner provided the Applicant with suggested claim language to place the application in condition for allowance. That claim language is included herein.

The Applicant's amendment and response is based on the understanding and insights gained from this telephone interview with the Examiner.

SPECIFICATION

The Examiner asserted the Applicant's specification included registered trademarks. The Applicant is unsure how to respond to this assertion. Respectfully, clarification is requested from the Examiner.

INFORMATION DISCLOSURE STATEMENT

The Applicant acknowledges the Examiner has considered all of the references on the Information Disclosure Statement filed on December 22, 2004.

Section 101 Rejection

The Examiner asserts "Claim(s) 1, 3-14, 15, 17-20, 22-28, 30-32, 34-35 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter."

Section 101 Response

The Applicant traverses this rejection and its associated assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant has added new claims and amended the existing claims to include a network device with one or more processors. The Applicant submits all of the claims include statutory subject matter. The Applicant requests all the Section 101 rejections be immediately withdrawn.

Section 102 Rejection

The Examiner asserts "Claim 20-24, 27 is rejected under 35 U.S.C. 102(e) as being anticipated by Dart (6529876)."

Section 102 Response

The Applicant traverses this rejection and its associated assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant as currently canceled Claims 15-33. The Applicant reserves the right to continue prosecution of the claims in continuation applications. The Applicant intends to make no other comments about these claims or the cited prior art at this time other than to traverse all of the Examiner's assertion of these claims.

The Examiner is reminded that a claim is anticipated under 35 U.S.C. §102 only if each and every element as set forth in the claim is found either, expressly or inherently described, in a single prior art reference. *Vergegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

The Examiner is also reminded that to maintain a *prima case* of anticipation, the identical invention must shown in as complete detail in a single prior art reference as is contained in the anticipated claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

With respect to the pending claims in the application, Dart does not expressly or inherently describe each and every claim element set forth in the claim invention. Dart does not teach or suggest the identical invention in as complete detail. Therefore none of the pending claims are anticipated under the holding of *Vergegall Bros.* or *Richardson*. Therefore, the all Section 102 rejections must be immediately withdrawn.

First Section 103(a) Rejection

The Examiner asserts “Claim(s) 1-11, 14-19, 28-32 is/are rejected under 35 U.S.C.103(a) as being unpatentable over Dart in view of Newman (A desk supporting computer-based interaction with paper documents).”

First Section 103(a) Response

The Applicant traverses this rejection and its associated assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant acknowledges and accepts the Examiner’s **admission** that “*Dart does not teach one or more digital images created from a paper.*”

Independent Claims 36 and 37:

The Examiner is reminded that the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S.____, 82 USPQ2d 1385, 1395-97 (2007) stated rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

The Applicant submits the Examiner has not supported a legal conclusion of obviousness under the holding of *KSR International Co.* The Applicant responds as follows.

1. The Claimed Invention was unpredictable, includes unexpected results and was not obvious to try.

The claimed invention was unpredictable and includes unexpected results that could not be expected nor predicted from the cited prior art, either alone or in combination.

The cited prior art does not teach, suggest, or even mention the claim elements, including but not limited to, those currently listed in independent Claims 36 and 37.

By the Examiner's admission, Dart does not teach using paper templates at all. Newman is a general document that simply described scanning in paper documents to a computer.

The claim elements just described are unexpected could not be predicted at all from Dart and Neuman.

None of the cited prior art, either alone or in combination, could be used to predict the claimed invention with its unexpected results. The claimed invention was not obvious to try.

2. Not All Claim Limitations Were Considered by the Examiner

The claimed invention, includes claim limitations not taught or suggested or even mentioned, by the prior art including, but not limited to, the claim elements listed for Number 1 above.

The Examiner is reminded that to establish a case of *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. The Examiner has not considered all the claim elements. *In re Royka* 400 F.2d 981 (CCPA 1974). Further, the Examiner is reminded that all words in a claim must be considered in

judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The Examiner has not considered all words in the claims drafted by the Applicant. The claim limitation including, but not limited to, those now listed in independent claims 36 and 37.

The combination of the two prior art references do not teach or suggest all of the claim limitations. Therefore, the combination of the two references is not obvious under the holdings of *In re Royka* and *In re Wilson*.

3. There is no Suggestion or Motivation to Modify the References

The Examiner is reminded that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR International Co.* 1396.

The Examiner is also reminded that a statement that modifications of the prior art to meet the claimed invention is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

The Examiner is also reminded that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. This is a guard against using hindsight in an obviousness analysis. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006).

The Examiner is also reminded if the proposed modification or combination of the prior art would change the principal operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti* 270 F.2d 810 (CPPA 1959).

The claimed invention is not predictable based on the combination of the prior art references based on the holding of *KSR*.

There is no objective reason to combine the references under the holding of *Ex parte Levensgood*.

There is no teaching or suggestion to combine the references under the holding of *In re Kahn*.

Combining the cited prior art would change at least one of the principal operations of Dart, namely, using paper templates instead of using electronic templates directly.

Combining the cited prior art would change at least one principal operation of Neuman, namely, providing electronic medical records coding.

Therefore, the claimed invention is not obvious based on the holding of *In re Ratti*.

Even if the cited prior art references could be combined technically, the combination of the references still do not teach or suggest all of the claimed limitations of the claimed invention. Therefore, the combination the cited prior art still does not render the claimed invention obvious.

4. There Is No Reasonable Expectation of Success for Combining the References.

The Examiner is reminded that evidence supporting no reasonable expectation of success of combining two or more references supports a conclusion of nonobviousness; *In re Reinhart*, 531 F.2d 1048 (CCPA 1976).

The cited prior art have significantly different trading interfaces and underlying architectures. There would be no reasonable expectation of success of combining Dart and Neuman. Even if these two references could be combined technically, the combination of the references still do not teach or suggest all of the claimed limitations of the claimed invention. Therefore, the claimed invention is not obvious based on the holdings of *In re Reinhart*.

5. The Combination of the Prior Art Teaches away from the Claimed Invention.

The Examiner is also reminded that a *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

The combination of Dart and Neuman teach away in many material respects including those claim elements included in independent Claims 36 and 37.

Therefore, the claimed invention is not obvious under the holding *In re Geisler*.

6. Conclusion for Independent Claim 36 and 37:

Thus, the claimed invention is not predictable and includes unexpected results not expected or predicted from the prior art to satisfy the non-obviousness requirements under the holding of *KSR International Co.* and all the other case cited above.

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected claims to allowance.

7. Dependent Claims:

The arguments for the independent claims discussed above are incorporated by reference. All of the independent claims are non-obvious over the cited prior art. All of the dependent claims add additional features not present in the independent claims. The Examiner is reminded that if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected claims to allowance.

Second Section 103(a) Rejection

The Examiner asserts "Claim(s) 12-13 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dart in view of Newman as applied to parent claim 1 above and further in view of Evans (5924074) and Official Notice."

Second Section 103(a) Response

The Applicant traverses this rejection and its associated assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant as currently canceled Claims 12-13 and 15-33. Therefore the Examiner's rejections are mute for claims 12 and 13.

The Applicant reserves the right to continue prosecution of the claims in continuation applications. The Applicant intends to make no other comments about these claims or the cited prior art at this time other than to traverse all of the Examiner's assertion of these claims.

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected claims to allowance.

Third Section 103(a) Rejection

The Examiner Asserts "Claim(s) 25-26 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dart in view of Evans and Official Notice.

Third Section 103(a) Response

The Applicant traverses this rejection and its associated assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant as currently canceled Claims 12-13 and 15-33. Therefore the Examiner's rejections are mute for claims 25 and 26.

The Applicant reserves the right to continue prosecution of the claims in continuation applications. The Applicant intends to make no other comments about these claims or the cited prior art at this time.

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected claims to allowance.

Fourth Section 103(a) Rejection

The Examiner Asserts “Claim(s) 33-35 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dart in view of Newman, Evans, and Official Notice.

Fourth Section 103(a) Response

The Applicant traverses this rejection and its associated assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant as currently canceled Claims 12-13 and 15-33. Therefore the Examiner’s rejections are mute for claim 33. In additions, dependent Claims 34 and 35 do not include the subject matter the Examiner cited for the Official Notice. Therefore the Applicant is not providing a detail traversal of the Official Notice because it is mute.

The Applicant reserves the right to continue prosecution of the claims in continuation applications. The Applicant intends to make no other comments about these claims or the cited prior art at this time.

With respect to claims 34 and 35, all of the arguments for the First Section 103(a) Response are incorporated by reference. Claims 34 and 35 are dependent on new independent Claim 37, in which the Examiner indicated includes allowable subject matter.

The arguments for the independent claims discussed above are incorporated by reference. All of the independent claims are non-obvious over the cited prior art. All of the dependent claims add additional features not present in the independent claims. The Examiner is reminded that if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected claims to allowance.

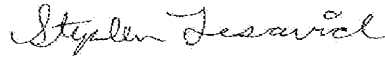
CONCLUSION

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw all the rejections of the claims and pass all of the claims to allowance.

Respectfully submitted.

Lesavich High-Tech Law Group, PC (32097)

Dated: June 9, 2009

A handwritten signature in cursive script, reading "Stephen Lesavich", is positioned above a horizontal line.

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